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EXAMINER

VANDERHORST, MARIA VICTORIA

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3688

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/858,174
Filing Date: May 15, 2001
Appellant(s): BUTTERWORTH, MARTYN IAN

Edward R. Lawson Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/07/2010 appealing from the Office action mailed 2/19/2010.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1, 4-8, and 18-25. Claims 2, 3, 9-17 and 26-34 were previously cancelled.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The rejection of claims 1, 4-8, 18 and 21-25 under 35 U.S. C. 102(b) by Statutory Invention Registration No. H0,001,714 ("Partridge").

The Examiner notes that the same set of claims, 1, 4-8, 18 and 21-25 are rejected under Gregorek's reference which is maintained.

(7) Claims Appendix

A response to notification of non-compliant appeal brief with corrected claims appendix was received on 6/15/2010.

(8) Evidence Relied Upon

5,428,670	Gregorek	06-1995
6,205,432	Gabbard	03-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, 18 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregorek, USP 5,428,670.

As per claims 1, 4-8, 18 and 21-25, Gregorek discloses a marketing system for selectively modifying an existing communication network (such as a telecommunication network) by modifying a portion of a processing software, which permits replacing at least a portion of a call progress signal generated by the communication network by a generally continuous pre-recorded announcement, such as advertisements (in text and/or audio/video format). A first station (telecommunication apparatus) is provided for placing a call, by a calling party or caller, at a first network address to send an (audio) message to a called party or recipient. The (telecommunication) network is adapted for connecting the call, from the caller, to an identified called station of the recipient at a second network address (establishing a connection with the telecommunication apparatus or called station of the recipient), the called station of the recipient (telecommunication apparatus) having either a busy status (unavailable) or an idle status (available). The network is configured to initially determine the busy/idle status of the called station and if the called station has an initial busy status, then the network or system checks the busy/idle status of the called station at predetermined intervals for an idle status. A player plays/displays at least one generally continuous announcement (or supplementary image or advertisement) to the calling party for a predetermined period of time during a time period when a call progress signal (conventional audio/visual)

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would have been provided to the calling party after the call was placed (playing/displaying a supplementary image or announcement or advertisement after the caller places a call to a called recipient and the recipient's station is in idle status, wherein the announcement replaces a conventional ring-back signal or audio/visual message played at the caller's station and terminating the supplementary message when the recipient answers or picks up the phone). Since the supplementary image or advertisement represents the ring-back signal, the transmission or the playing of the supplementary image via the caller's telecommunication apparatus ceases when the called party or recipient answers or picks up the phone at the other end. The player (system) determines the announcement (supplementary image) to be played (displayed) based upon criteria established exclusively by the marketing system (e.g. advertiser) and independently of the identity of the called station. The playing of the announcement (supplementary image) is **terminated** and the call is completed to the calling station, in the case of the calling station having an initial idle status, when the called station or the telecommunication apparatus of the call recipient responds by answering the (incoming) call from the caller or calling party (terminating the playing/displaying of the announcement or supplementary image when the called station answers the incoming call after the connection has been established). It is herein understood that both the caller's station and the recipient's station are configured to receive and transmit audio/visual (mixed media audio/video) information or messages. (See abstract; col. 1: 12-20; col. 1: 53 to col. 2: 54; col. 3: 11-50; col. 7: 1-10; col. 7: 54-59; col. 9: 14-22; figs. 1 and 3-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek, USP 5,428, 670 in view of Gabbard, USP 6,205,432.

As per claims 19-20, Gregorek does not disclose that the caller inserts a supplementary image (ad) into the message sent to the recipient, and if the message is a text messaging, then the supplementary image is inserted in part of the message from the caller and will be visible to the recipient on retrieval (receipt) of the (text) message.

However, Gabbard discloses an advertisement system and method for inserting into an end-user's communication message or e-mail a background reference to an advertisement. The background reference causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an e-mail message (or public posting) that will be sent from the user or sender to an another user or recipient. A message server inserts the background reference (ad) after receiving a message or an e-mail (text message) originally sent from an end-user originator (sender) and before

sending the message to be delivered to an end-user recipient (recipient). When necessary, the message server will convert at least a portion of the message into a proper format, such as HTML, before inserting the background reference to an advertisement, which is preferably selected in accordance with end user recipient demographic information and/or ad exposure statistics. The advertisement itself, often a graphical file, is preferably not transmitted with the message, but is typically stored at the message server or other location remote from the end-user recipient. Preferably, the message server maintains and refers to records on each end-user recipient to allow for selective enablement of background reference insertion and overwriting based upon end user preferences. According to various "non-web" example embodiments, the message server transmits an SMTP, POP3 or NNTP message with an HTML portion for a respective HTML-compatible client. In other "web-based" example embodiments, the message server transmits the entire message in HTML to be used as a stand-alone web page or as a portion of a larger page employing frames or tables (see abstract).

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Gregorek so as to send by a sender/caller a message, text message or e-mail message to a recipient, via a communication network or telecommunication system, wherein a server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail message is delivered or played/displayed to the caller or recipient, thereby taking advantage of a text message or e-mail message sent, by a sender/caller, to a recipient to present to the recipient a

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targeted ad (supplementary image), based on the recipient's profile, inserted into the e-mail message before it is delivered to the recipient, while enabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail.

(10) Response to Arguments

I. Regarding to the rejection of claims 1, 4-8, 18 and 21-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,428,670 ("Gregorek").

Appellant argues: Brief at 10

Independent Claim 1

Independent claim 1 defines

A method for transmitting pre-recorded images using telecom networks, the method comprising the steps of:

detecting when a telecommunications apparatus is used by a caller to send a message to a recipient, establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.

Gregorek discloses a communications marketing system 10 in which a calling party using a first telephone 12 places a call to a called party at with a second telephone 20. The system first determines the status of the second telephone 20, i.e., whether the second telephone is in a busy state or in an idle state. An audible generator or audible signal generator 14 is capable of generating a ringback signal if the called network address or station line is idle, i.e., the second telephone 20 is not in use, or a busy signal if the called network address or station line is busy, i.e., the second telephone 20 is in use. In Gregorek, a message generator 16 is provided to play a series of prerecorded announcements to the calling party for a predetermined period of time.

In Gregorek, if the second telephone is idle, the audible signal generator 14 can produce a conventional audible ringback signal, or the message generator 16 can play a series of prerecorded announcements to the calling party for a predetermined period of time. If the second telephone 20 is busy, the audible signal generator 14 can generate a busy signal, or the message generator 16 can play a series of pre-recorded announcements to the calling party for a

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predetermined period of time while periodically checking to determine if the second telephone 20 is still busy. This process continues until the second telephone 20 is idle and as long as the calling party does not abandon the call. If the second telephone 20 is answered, the message generator 16 enters a completed call sequence, and the call is completed. If the call has been abandoned, i.e., the first telephone 12 is on-hook, the message generator 16 also enters a completed call sequence.

In response, Appellants appears to merely recognize advantages from the prior art of record.

Appellant argues: Brief at 11

Gregorek does not teach or suggest, among other things, a method including establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Gregorek only discloses that the message generator 16 enters the completed call sequence if the second telephone is answered or if the call has been abandoned. Gregorek does not teach or suggest that, after establishing a connection with the second telephone 20, if the second telephone 20 is not answered during a predetermined time period, then replacing the announcement by connection message text. In fact, Gregorek does not teach or suggest that, in any instance, if the second telephone is not answered during a predetermined time period, then replacing the announcement by connection message text. This subject matter is completely absent from Gregorek.

The Examiner disagrees with the Appellant because, First of all, Gregorek's system comprises a network that can be used with any type of communications, including voice, data (text), video, multimedia, etc, (Col. 3: 10-31).

Secondly, Gregorek's system modifies a communication in process in a network for replacing at least a portion of the audible or visual call progress signal, (conventional signal including text or data) by a prerecorded announcement, Col. 1:10-20,

Thirdly, Gregorek's system discloses that the transmission of the announcement is until the called party answers, Fig. 3.

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Finally, Gregorek's system comprises functionality to control prerecorded announcements to the calling party for a predetermined period of time, see at least Col. 5:35-65.

The Examiner notes that for purposes of examination, prior art is interpreted to meet the limitation "...if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text ...", where prior art discloses "...A possible time frame for again trying to make the connection to the second telephone is every fifteen seconds. However, it is to be understood by those skilled in the art that any other suitable time frame, including a variable time frame, could be used in the alternative...", Col. 5:35-65.

It is inherent that after the mentioned time frame, the system will try to make the connection with audible or visual call progress signal as expressed on Col. 1:10-20.

Appellant argues: Brief at 11

The Examiner contends that an "if-then" claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the 'if-then' claim limitation." Office Action, dated February 19, 2010, page 2. Applicant disagrees and submits that the Examiner is ignoring the clear language of the claim which requires both that "if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text" and that "if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated." Accordingly, in order to anticipate or render obvious the claim, Gregorek must teach or suggest both limitations. As discussed above, Applicant submits that Gregorek at least does not teach or suggest that if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Again, this subject matter is completely absent from Gregorek.

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The Examiner disagrees with the Appellant because, the Examiner is not ignoring any of the limitations from the instant Application. Both limitations on the claim have been disclosed in the prior art of record, Gregorek:

a) "if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text", see at least Col. 5:35-65, trying again to make the connection.

b) "if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.", see at least Figs. 5 and 7.

Regarding to the 35 U.S.C § 102 rejection, the prima facie of anticipation on this case has been established. Gregorek's reference anticipates the limitations on the claims. Gregorek's method and system transmit an announcement if the recipient does not answer for a predetermined period of time, i.e. fifteen seconds. After, again the system of Gregorek try to make the connection, this is to send a connection signal.

Appellant argues: Brief at 12

For at least these independent reasons, Gregorek does not teach or suggest the subject matter defined by independent claim 1. Accordingly, Applicant respectfully requests reversal of the rejection of claim 1 as being anticipated by Gregorek under 35 U.S.C. §102(b). Dependent claims 4-8 depend from independent claim 1 and are allowable for at least the same and other independent reasons.

The Examiner disagrees with the Appellant because the prima facie of anticipation on this case has been established. Gregorek's reference anticipates the limitations on the claim 1.

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Appellant argues: Brief at 12 and 13

Independent Claim 18

Independent claim 18 defines

An apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller to send a message to a recipient, a supplementary image is visually transmitted from messaging equipment to the caller in addition to, or to replace, conventional connection messages, wherein the apparatus comprises:

means for detecting a signal on a telecom system indicating that there is an incoming message transmission;

means for establishing a connection with a telecommunications apparatus of the recipient;

and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated.

Gregorek does not teach or suggest, among other things, an apparatus including means for establishing a connection with a telecommunications apparatus of the recipient, and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text. Gregorek only discloses that the message generator 16 enters the completed call sequence if the second telephone is answered or if the call has been abandoned. Gregorek does not teach or suggest that, after a connection with the second telephone 20 is established, if the second telephone 20 is not answered during a predetermined time period, then replacing the announcement by connection message text. In fact, Gregorek also does not teach or suggest that, if the second telephone 20 is not answered during a predetermined time period, then any means for responding to this detection and connection replacing the supplementary image by connection message text. This subject matter is completely absent from Gregorek.

The Examiner disagrees with the Appellant because, First of all, Gregorek's system comprises a network that can be used with any type of communications, including voice, data (text), video, multimedia, etc, (Col. 3: 10-31).

Secondly, Gregorek's system modifies a communication in process in a network for replacing at least a portion of the audible or visual call progress signal, (conventional signal including text or data) by a prerecorded announcement, Col. 1:10-20,

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Thirdly, Gregorek's system discloses that the transmission of the announcement is until the called party answers, Fig. 3.

Finally, Gregorek's system comprises functionality to control prerecorded announcements to the calling party for a predetermined period of time, see at least Col. 5:35-65.

The Examiner notes that for purposes of examination, prior art is interpreted to meet the limitation "...if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text ...", where prior art discloses "...A possible time frame for again trying to make the connection to the second telephone is every fifteen seconds. However, it is to be understood by those skilled in the art that any other suitable time frame, including a variable time frame, could be used in the alternative...", Col. 5:35-65.

It is inherent that after the mentioned time frame, the system will try to make the connection with audible or visual call progress signal as expressed on Col. 1:10-20.

Appellant argues: Brief at 13

As discussed above, the Examiner contends that an "if-then" claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the 'if-then' claim limitation." Office Action, dated February 19, 2010, page 2. Applicant again disagrees and submits that the Examiner is ignoring the clear language of the claim which requires both "if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text" and "if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated." Accordingly, in order to anticipate the claim, Gregorek must teach both limitations. As discussed above, Applicant submits that Gregorek at least does not teach or suggest that if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection

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replacing the supplementary image by connection message text. Again, this subject matter is completely absent from Gregorek.

For at least these independent reasons, Gregorek does not teach or suggest the subject matter defined by independent claim 18. Accordingly, Applicant respectfully requests reversal of the rejection of claim 18 as being anticipated by Gregorek under 35 U.S.C. §102(b). Dependent claims 19-25 depend from independent claim 18 and are allowable for at least the same and other independent reasons.

The Examiner disagrees with the Appellant because, the Examiner is not ignoring any of the limitations from the instant Application. Both limitations on the claim have been disclosed in the prior art of record, Gregorek, a) "if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text", see at least Col. 5:35-65, trying again to make the connection. b) "if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.", see at least Figs. 5 and 7.

Regarding to the 35 U.S.C § 102 rejection, the prima facie of anticipation on this case has been established. Gregorek's reference anticipates the limitations on the claims. Gregorek's method and system transmit an announcement if the recipient does not answer for a predetermined period of time, i.e. fifteen seconds. After, again the system of Gregorek try to make the connection, this is to send a connection signal.

Therefore, the prima facie of anticipation on this case has been established. Gregorek's reference anticipates the limitations on the claim 1.

II. Rejection of claims 1, 4-8, 18 and 21-25 under 35 U.S.C. § 102(b) as being anticipated by Statutory Invention Registration No. H1714 ("Partridge")

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This rejection was withdrawn, the rejection of claim 1 is based solely in Gregorek's reference. Please see response to Appellant's arguments, brief, page 10.

Appellant argues: Brief at 14

Independent Claim 1

The language of independent claim 1 is presented above and in the Claims Appendix. Partridge discloses automatic still image transmission upon call connection for a "caller ID". In Partridge, a customer preselects or pre-approves one or more stored images that the customer wants to be displayed as its "telephone calling card" to parties it calls. Col. 2, lines 53- 65.

In operation, the customer (calling party at terminal 10) calls another party (at called terminal 80). Image processor 60 retrieves a stored image (selected or pre-approved by the customer or associated with the customer) from the image storage unit 50 and transmits the image to the called terminal 80. Col. 5, lines 29-32, 48-51. The image can be transmitted upon establishment of a path to called terminal 80, before or with the first ring, after a number of rings, or after the called party answers. Col. 5, lines 51-64.

Partridge does not teach or suggest, among other things, a method for transmitting pre-recorded images using telecom networks, the method including displaying on the caller equipment a supplementary image to replace conventional connection messages. There is no teaching or suggestion in Partridge to display on the caller equipment a supplementary image. As discussed above, Partridge is directed to a "caller ID" with stored images only being displayed as a calling party's "telephone calling card" to parties it calls.

Partridge also does not teach or suggest such a method in which, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Partridge is completely silent as to what happens if the called party does not answer during a predetermined time period. In addition, Partridge does not teach or suggest that, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated. In contrast, Partridge discloses that the image may continue to be transmitted after the called party answers. Col. 5, lines 60-64.

For at least these independent reasons, Partridge does not teach or suggest the subject matter defined by independent claim 1. Accordingly, Applicant respectfully requests reversal of the rejection of claim 1 as being anticipated by Partridge under 35 U.S.C. § 102(b). Dependent claims 4-8 depend from independent claim 1 and are allowable for at least the same and other independent reasons.

This rejection was withdrawn, the rejection of claim 1 is based solely in Gregorek's reference. Please see response to Appellant's arguments, brief, page 10.

Appellant argues: Brief at 15

Independent Claim 18

The language of independent claim 18 is presented above and in the Claims Appendix. Partridge does not teach or suggest, among other things, an apparatus used for transmitting pre-recorded images using telecom networks, the apparatus comprising means for responding to detection and

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connection by conveying a supplementary image or images to the caller on the caller equipment a supplementary image to replace conventional connection messages. There is no teaching or suggestion in Partridge by conveying a supplementary image or images to the caller on the caller equipment a supplementary image to replace conventional connection messages. As discussed above, Partridge is directed to a "caller ID" with stored images only being displayed as a calling party's "telephone calling card" to parties it calls.

Partridge also does not teach or suggest such an apparatus in which, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Partridge is completely silent as to what happens if the called party does not answer during a predetermined time period.

In addition, Partridge does not teach or suggest that, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated, supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated. In contrast, Partridge discloses that the image may continue to be transmitted after the called party answers. Col. 5, lines 60-64.

For at least these independent reasons, Partridge does not teach or suggest the subject matter defined by independent claim 18. Accordingly, Applicant respectfully requests reversal of the rejection of claim 1 as being anticipated by Partridge under 35 U.S.C. § 102(b). Dependent claims 19-25 depend from independent claim 18 and are allowable for at least the same and other independent reasons.

This rejection was withdrawn, the rejection of claim 18 is based solely in Gregorek's reference. Please see response to Appellant's arguments, brief, page 12.

III. Rejection of claims 19-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,428,670 ("Gregorek) in view of U.S. Patent No. 6,205,432 ("Gabbard")

Appellant argues: Brief at 16

Dependent Claim 19

Dependent claim 19 depends from independent claim 18 and specifies that the apparatus is arranged to insert a supplementary image or images into the message and relay the message with inserted supplementary image(s) to a recipient. Dependent claim 20 depends from dependent claim 19 and further specifies that in the case of text messaging the supplementary image(s) is/are inserted in a part of a message from the caller and will be visible to the recipient on retrieval of the text message. As discussed above, Gregorek does not teach or suggest the subject matter defined by independent claim 18. Gabbard does not cure the deficiencies of Gregorek.

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Gabbard discloses an advertisement system and method for inserting into an end-users communication message or email a background message to an advertisement. The background message causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an email message or public posting.

The combination of Gregorek and Gabbard suggested by the Examiner still fails to teach or suggest at least an apparatus used for transmitting pre-recorded images using telecom networks, the apparatus comprising means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, wherein, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and wherein, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated. Applicant respectfully submits that even the addition of subject matter arguably disclosed in Gabbard to the communications marketing system 10 of Gregorek does not cure these deficiencies.

For at least these independent reasons, the Examiner has failed to present a prima facie case of obviousness as required by 35 U.S.C. § 103. Accordingly, Applicant respectfully requests reversal of the rejection of claims 19-20 as being obvious over Gregorek in view of Gabbard under 35 U.S.C. §103

The Examiner disagrees with the Appellant because, First of all, Gabbard discloses an advertisement system and method for inserting into an end user communication message a reference to an advertisement. His system when uses a web-based solution inserts in the HTML tags a reference to advertisement and when the user open the message to read it, he see an advertisement in the background, Col. 4:37-67.

Secondly, the combination of Gregorek and Gabbard discloses all the limitations of claim 19.

Finally, regarding to 35 U.S.C § 103 rejection, the prima facie of obviousness has been established. Gregorek's reference combined with Gabbard's reference discloses all the limitations on the claims. The Examiner respectfully notes that Appellant has not provided rebuttal evidence to overcome the prima facie case. Further, the elements of this instant Application are old and well known at the time of the invention. The combination set for the rejection produce results that are predictable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/M. VICTORIA VANDERHORST/
Examiner, Art Unit 3688

/James W Myhre/
Primary Examiner, Art Unit 3688

Conferees:

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